

**REMARKS**

Claims 14-22, 24 and 25 are pending. Claims 1-13 and 23 have been canceled without prejudice.

Claims 14 and 25 have been amended to recite that the polymer-molding material is made of a non-polar hydrocarbon. Also, claims 14 and 25 have been amended to recite a specific range of film thickness as was recited in original claim 23.

Claim 22 has been amended to recite that the polymer-molding material is a linear olefin resin or a cyclic olefin resin. Support for this amendment can be found in page 19, beginning at second full paragraph.

No new matter has been added by way of the above-amendment.

**Rejection Under 35 U.S.C. § 112, Second Paragraph**

Claims 1-10, 12-22 and 24-25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the rejection.

Specifically, the Examiner objects to the term "thin." In response, Applicants have amended claims 14 and 25 to recite that the film thickness is 1 nm to 100 microns. Support for this amendment can be found on page 27, line 4 of the specification and in original claim 23. Reconsideration and withdrawal of the rejection is respectfully requested.

### **Prior Art Based Rejection**

The following prior art based rejections are pending:

(A) Claims 1, 5-9, 11, 13-14, 18-20, 23 and 25 are rejected under 35 U.S.C. 102(b) a being anticipated by Kondo et al. (US 4,424,267);

(B) Claims 1, 5-8, 10, 11 and 13 are rejected under 35 U.S.C. 102(b) a being anticipated by Narui et al. (US 4,687,680); and

(C) Claims 2-4, 10, 15-17, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al.

Applicants respectfully traverse the prior art based rejections.

Claims 14 and 25 are drawn to a laminate and a process of preparing said laminate, respectively, wherein the laminate comprises:

- a polymer substrate in which a cyclized rubber which is a conjugated diene polymer cyclized product or a derivative thereof is incorporated into a polymer-molding material made of a non-polar hydrocarbon; and
- a thin film laminated on the surface of the polymer substrate by a dry film-forming process,
- wherein the film thickness of the thin film is from 1 nm to 100µm.

The laminate recited in the amended claim 14 (present invention) is achieved by focusing on a problem in film-forming that the adhesiveness of the thin film is poor. This problem is caused when a dry film-forming process is applied to a polymer substrate made of a non-polar hydrocarbon resin such as a polyethylene film or a polypropylene film (see the disclosure of the present specification at page 3, line 23 to page 4, line 24).

The present invention solves such a problem and achieves the following advantageous effect by incorporating a cyclized rubber into a non-polar hydrocarbon resin. Even if the polymer substrate is a polymer substrate made of a nonpolar polymer, the present invention can produce a laminate which is good in adhesiveness between its substrate and its thin film

laminated thereon by a dry film-forming method such as a chemical vapor growth method or a vacuum evaporation method (page 8, lines 13-21.

Kondo et al. disclose a laminate wherein a support, a metal deposition layer and a curable rubber layer are laminated together. Kondo et al further teach that a cyclized rubber or a combination of a cyclized rubber with other resins may be used as the curable resin layer.

Nonetheless, Kondo et al do not disclose to use a non-polar hydrocarbon resin as the other resins which may be combined with the cyclized rubber. Accordingly, unlike the present invention, it is apparent that Kondo et al do not teach to use a layer where a cyclized rubber is incorporated into a non-polar hydrocarbon resin as the curable rubber layer, as presently claimed.

Narui et al. disclose a stamping foil where a support web, a lubricating layer and a metal deposition layer are laminated in this order. Narui et al further disclose that a cyclized rubber can be used as the lubricating layer.

Although Narui et al disclose the formation of a lubricating layer by a resin or a rubber, it does not disclose to use a mixture of a resin and a rubber. Thus, unlike the present invention, it is apparent that Narui et al do not teach to use a non-polar hydrocarbon resin with a cyclized rubber incorporated therein.

As the MPEP directs, all the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of anticipation or obviousness. See MPEP §§ 2131 and 2143.03.

In light of the above, unlike the present invention, as neither of Kondo et al nor Narui et al disclose to use a polymer substrate wherein a non-polar hydrocarbon resin has a cyclized rubber incorporated therein, the present invention is neither anticipated nor rendered obvious over Kondo et al or Narui et al.

Moreover, as explained, even when the polymer substrate is a polymer substrate made with a nonpolar polymer, the present invention attains the advantageous effect of producing a laminate which has good adhesiveness between its polymer substrate and its deposited thin film by using a non-polar hydrocarbon resin with a cyclized rubber incorporated therein.

Accordingly, the present invention has advantages not found in the teachings of Kondo et al. or Narui et al. in forming a deposited thin film on a non-polar hydrocarbon resin.

Furthermore, Applicants note that the Examiner has not combined the teachings of Kondo et al. with Narui et al. in a single rejection. It appears that the Examiner is aware that such a combination is improper, since there would be no rational reason for an artisan to look to the teachings of Narui et al in the stamping foil art to modify the teachings of Kondo et al in the electrophotographic image art (or vice versa). As their applications are totally different from each other, they are not combinable.

Reconsideration and withdrawal of the rejections are respectfully requested.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen Reg. No. 43,575 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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